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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,437	11/10/2003	Ken'ichi Imamura	FUJI 17.634A	4605
26304	7590	10/06/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			WOOD, WILLIAM H	
			ART UNIT	PAPER NUMBER
			2193	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/705,437	IMAMATSU, KEN'ICHI	
	Examiner	Art Unit	
	William H. Wood	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 12-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/10/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 12-21 are pending and have been examined.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10 November 2003 has been considered by the examiner as indicated on the 1449 form.

Priority

2. Acknowledgment is made of applicant's claim for priority.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 13 requires "notif[ying] a number of divided blocks". It is not known how a block can be notified.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 12-13 and 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

First, though claims 12-13 recite “a memory”, this is considered a software abstraction of a real and tangible memory as the claims are directed toward a “software device”. “Software device” claims being comprised of merely software “units” or “modules” are software per se and lack hardware. The claims are rejected as software.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims

an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 12-15, 18 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 5, 7, 8 and 10 of U.S. Patent No. 6,687,901. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application claims 12, 13, 14, 15, 18 and 19 correspond to patent 6,687,901 claims 4, 10, 4, 8, 7 and 5 respectively.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 12-21 are rejected under 35 U.S.C. 102(e) as being anticipated by **Hansson** (USPN 6,023,620).

Claim 12

Hansson disclosed a software device comprising:

a communication unit communicating with a radio terminal device (*figure 1, element 120*); and

a memory storing a first control-software relating to a radio communication function of a radio terminal device (*figure 1, element 100*), wherein said first control-software is downloaded by said radio terminal device under the controlling of a second control-software, stored in each radio terminal device, relating to a communication function and said downloaded first control-software replaces at least one part of said stored second control-software (*column 1, lines 40-56*).

Claim 13

Hansson disclosed a software device comprising:

a communication unit communicating with a radio terminal device (*figure 1, element 120*); and

a memory storing a control-software being downloaded by said radio terminal device (*figure 1, element 100*);

wherein said communication unit notifies a number of divided blocks for transmitting of said stored control-software before transmission of said stored control-software occurs (*column 2, lines 41-56*).

Claim 14

Hansson disclosed a radio terminal device comprising:

a radio communication unit communicating with a software-supply device (*figure 1, element 110*);

a memory storing a control-software presently involved in operations and update-software to start updating said control-software presently involved (*column 1, lines 40-56*); and

a controller downloading a control-software from said software-supply device (*figure 1, element 140*) and

updating said control-software stored in said memory by said downloaded control software, wherein said update-software is not updated by said downloading (*column 2, lines 16-40*).

Claim 15

Hansson disclosed a radio terminal comprising:

a radio communication unit communicating with a software-supply device (*figure 1*);
a memory storing a control-software presently involved in operations (*figure 1*); and
a controller inhibiting communications with said software-supply device for updating said control-software based on a power condition of said radio terminal device (*figure 1, element 140, cannot communicate when off*).

Claim 16

Hansson disclosed a radio terminal comprising:

a radio communication unit communicating with a software-supply device (*figure 1*);
a memory storing a control-software presently involved in operations (*figure 1*); and
a controller inhibiting communications with said software-supply device when said radio terminal is communicating with another device (*column 2, lines 50-51; figure 2, elements 250-320, no other communicating present*).

Claim 17

Hansson disclosed a radio terminal comprising:

- a radio communication unit communicating with a software-supply device (*figure 1*);
- a memory storing a control-software presently involved in operations (*figure 1*); and
- a controller stopping a download of control-software from said software-supply device when the controller detects an operation for responding to an incoming call (*column 4, lines 36-42*).

Claim 18

Hansson disclosed a radio terminal comprising:

- a radio communication unit communicating with a software-supply device (*figure 1*);
- a memory storing a control-software presently involved in operations (*figure 1*); and
- a controller making a request to said software-supply device at least N times for receiving a plurality of divided control-software blocks via a radio communication line for updating said stored control-software (*figure 2, element 210, N=1*).

Claim 19

Hansson disclosed a radio terminal comprising:

a radio communication unit communicating with a software-supply device (*figure 1*);
a memory storing a control-software presently involved in operations (*figure 1*); and
a receiving unit receiving information from said software-supply device concerning a number of divided control-software blocks for updating said stored control-software, before starting a download of said number of divided control-software blocks (*figure 2, elements 200-240*).

Claim 20

Hansson disclosed a radio terminal comprising:

a radio communication unit communicating with a software-supply device (*figure 1*);
a memory storing a control-software presently involved in operations (*figure 1*); and
a controller downloading a control-software from said software-supply device and writing said downloaded control-software into said memory after deleting one or more corresponding parts of said stored control-software (*column 2, lines 16-40, overtime downloading to the alternating memories, deletes old information*).

Claim 21

Hansson disclosed a radio terminal comprising:

a radio communication unit communicating with a software-supply device (*figure 1*);

a memory means storing a control-software presently involved in operations (*figure 1*); and

a controller downloading a control-software from said software-supply device and accepting no operation by a user of said radio terminal device while updating said stored control-software with said downloaded control-software (*figure 2, elements 250-320, no user operations present*).

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (571)-272-3736. The examiner can normally be reached 9:00am - 5:30pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)-272-3719. The fax phone numbers for the organization where this application or proceeding is assigned are (571)273-8300 for regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained form either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see <http://pair-direct.uspto.gov>. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.



William H. Wood
Patent Examiner
AU 2193
October 2, 2006